

PATENT**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:)	
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Limor Schweitzer)	Group Art Unit: 3692
)	
Application No. 09/879,683)	Examiner: Milef, Elda G.
)	
Filed: 06/11/2001)	Atty. Docket No. AMDCP006
)	
For: SYSTEM, METHOD AND)	Date: 07/01/2008
COMPUTER PROGRAM PRODUCT FOR)	
ALLOWING A CARRIER TO ACT AS A)	
CREDIT-APPROVAL ENTITY FOR)	
E-COMMERCE TRANSACTIONS)	
)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTENTION: Board of Patent Appeals and Interferences**REPLY BRIEF (37 C.F.R. § 41.37)**

This Reply Brief is being filed within two (2) months of the mailing of the Examiner's Answer mailed on 05/01/2008.

Following is an issue-by-issue reply to the Examiner's Answer.

In the Examiner's answer mailed 05/01/2008, the Examiner has stated on Page 2, under section "(4) Status of Amendments After Final", that "[t]he appellant's statement of the status of amendments after final rejection contained in the brief is incorrect." Further, the Examiner has stated that "[n]o amendment after final was filed by the [appellant]" and that "[t]he final rejection was mailed 6/26/2007."

Appellant respectfully disagrees and asserts that appellant's statement under section "IV STATUS OF AMENDMENTS" in the Appeal Brief filed 03/04/2008 is correct. Specifically, appellant asserts that, per the Advisory Action mailed 11/02/2006, the Examiner did not enter appellant's Amendment B, which was filed on 07/05/2006 in response to the Final Office Action mailed 05/05/2006.

Issue # 1:

The Examiner has rejected Claims 1, 3, 8-12, 27, 28, and 30 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

Group #1: Claims 1, 3, 8-12, 27, 28, and 30

With respect to Claim 1, the Examiner has stated that there is insufficient antecedent basis for the limitation "the information" in line 9. Appellant respectfully disagrees and asserts that, clearly, "the information" refers to the limitation of "receiving information utilizing a network, wherein the information includes..." (emphasis added), as claimed by appellant.

In the Examiner's Answer mailed 05/01/2008, the Examiner has argued that "the rejection [is maintained] because it is unclear which information the limitation is referring, (i.e., received information or shipping information)."

Again, appellant respectfully disagrees and asserts that, "the information" clearly refers to the limitation of "receiving information utilizing a network, wherein the information includes..." (emphasis added), as claimed by appellant.

Furthermore, also with respect to Claim 1, the Examiner has argued that the meaning of the limitation “wherein the site sends the information” is unclear and has questioned “[w]here...the information [is] being sent.” Appellant respectfully disagrees and asserts that Claim 1 is not limited to a specific location to which the information is sent.

In the Examiner’s Answer mailed 05/01/2008, the Examiner has argued that “[t]his limitation is confusing” and that “[i]t is unclear what is in fact being accomplished by the site, what information is being sent by the site, and finally to whom the information is being sent.” Further, the Examiner has argued that “[t]he claim limitation is vague and indefinite and does not allow for a clear understanding of the invention.”

Again, appellant respectfully disagrees and asserts that appellant’s claimed technique “wherein the site sends the information,” as claimed, is not limited to sending the information to a specific location. Additionally, appellant clearly claims a technique “wherein a uniform resource locator (URL) link is provided to the user from the site” (emphasis added), as claimed. Therefore, appellant’s Claim 1 is clearly definite.

Issue # 2:

The Examiner has rejected Claims 1, 8-11, 13, 20-23, 25-28, and 30 under 35 U.S.C. 103(a) as being unpatentable over Ronen (U.S. Patent No. 5,905,736), in view of Egendorf (U.S. Patent No. 5,794,221), and in further view of Foster (U.S. Patent No. 6,332,134).

Group #1: Claims 1, 8-11, 13, 20-23, 25, 27, and 28

With respect to independent Claims 1, 13, and 25, the Examiner has relied on Col. 5, lines 52-67 and Cols. 2, 5, and 6 from the Ronen reference, in addition to Col. 4, lines 1-6 from the Egendorf reference to make a prior art showing of appellant’s claimed technique “wherein user data is identified based on the received information, and the user data is sent to a site, wherein the user data includes shipping information” (see this or similar, but not necessarily identical language in the aforementioned independent claims).

Appellant respectfully asserts that the excerpts from Ronen relied upon by the Examiner merely teach that “[b]efore completing the transaction, therefore, the accessed ISP, such as ISP 106, communicates with the transaction server 109 to determine whether that IP address has an established billing entry to which charges for the transaction can be forwarded and recorded,” and that “[i]f such an entry exists on database 110 and a billing mechanism is in place, ISP 106 is signaled over the secured link, to authorize the transaction” (Ronen, Col. 5, lines 52-66 - emphasis added). Furthermore, the excerpt from Egendorf relied on by the Examiner simply teaches that “the vendor may verify with the provider that the address supplied by the customer for shipment of the goods has been authorized by the customer” (Egendorf, Col. 4, lines 1-3 - emphasis added).

Clearly, the excerpts from Ronen relied on by the Examiner merely disclose “determin[ing] whether [an] IP address has an established billing entry,” which does not even suggest any sort of “shipping information,” as appellant claims. Further, the excerpt from Egendorf relied on by the Examiner only discloses that “the address [is] supplied by the customer for shipment,” which does not suggest, and even *teaches* away from appellant’s claimed technique “wherein user data is identified based on the received information...wherein the user data includes shipping information,” particularly since such received information “includes an Internet Protocol (IP) address of a user and an amount of payment due” (emphasis added), in the context claimed by appellant.

In addition, although Egendorf discloses that “the vendor may verify with the provider that the address... has been authorized by the customer,” Egendorf only discloses that such verification may be performed “in the same manner in which such verification would be made for the same transaction made over the telephone with a credit card.” Thus, Egendorf simply does not meet appellant’s specific claim language, namely that “user data is identified based on the received information...wherein the user data includes shipping information” and where such received information “includes an Internet Protocol (IP) address of a user and an amount of payment due” (emphasis added), in the context claimed by appellant.

Appellant further notes that the Examiner has argued that “Ronen discloses the purchasing of goods that will later be delivered by conventional transport means,” such that “[i]t is obvious that in order for goods ordered online to be shipped to a consumer, the consumer must provide shipping information.” Appellant again emphasizes that merely suggesting that Ronen teaches that a “consumer must provide shipping information,” as alleged by the Examiner, fails to rise to the level of specificity of appellant’s claim language, and even *teaches away* from such claim language. Appellant emphasizes that only appellant teaches and claims a technique where “user data [that includes shipping information] is identified based on received information,” where such received information “includes an Internet Protocol (IP) address of a user and an amount of payment due” (emphasis added), in the context claimed by appellant.

In the Examiner’s Answer mailed 05/01/2008, the Examiner has argued that “columns 2, 5, and 6...[in] Ronen disclose a billing platform which uses the IP address identity of the user [received information].” Further, the Examiner has argued that in “col. 1 lines 13-20, Ronen disclose that the billing server cross-references the IP address associated with the cost of the transaction received from the ISP with the IP address/user-identity relationship received from the IAP to properly charge an established account of the user [user data is identified].” Additionally, the Examiner has argued that “Ronen disclose that the user data [IP address of the user] is sent to a site-see col. 5 lines 64-65 ‘ISP 106 is signaled over the secured link to authorize the transaction’, and Figs. 2 -3 user’s IP address.” In addition, the Examiner has argued that “Ronen further disclose a user inputs a service request that will incur a transaction charge-col. 7 lines 7-14.”

Appellant respectfully disagrees and asserts that the excerpts from Ronen relied upon by the Examiner teach that “the Internet Protocol (IP) address that is assigned to the user by the IAP upon connection, is transmitted to a billing platform together with the associated identity of the user, which is known to the IAP through normal log-on procedures” (Col. 2, lines 8-13 – emphasis added). Further, the excerpts teach that “[t]he billing server then cross-references the IP address associated with the cost of the transaction received from the ISP with the IP-address/user-identity relationship received from the IAP to properly charge an established account of the user for the transaction” (Col. 2, lines 16-20 – emphasis added). Additionally, the excerpts teach that “[i]f [an entry exists for the ISP address of the initiating user] on database 110 and a billing mechanism is in place, ISP 106 is signaled over the secured link, to authorize the

transaction” (Col. 5, lines 64-66 – emphasis added). In addition, the excerpts teach that “the user inputs a service request that will incur a transaction charge, such as requesting access to specific information, or requesting downloading of software” (Col. 7, lines 11-14 – emphasis added).

However, teaching that an ISP transmits an IP address identity of a user making a transaction and the cost of the transaction to a billing platform, where a billing server cross-references the IP address with an IP-address/user-identity relationship received from the IAP to properly charge an established account of the user for the transaction, where the transaction may include a service request that will incur a transaction charge, and where the ISP may be signaled to authorize the transaction if an account is established, as in Ronen, simply fails to suggest a technique “wherein user data is identified based on the received information, and the user data is sent to a site, wherein the user data includes shipping information” (emphasis added), in the context claimed by appellant. Clearly, cross-referencing the received IP address with the IP-address/user-identity relationship in order to properly charge an established account of the user for the transaction, in addition to signaling an ISP to authorize a transaction if an account is established, as in Ronen, simply fails to even suggest a technique “wherein user data is identified based on the received information, and the user data is sent to a site, wherein the user data includes shipping information” (emphasis added), in the context claimed by appellant.

Additionally, in the Examiner’s Answer mailed 05/01/2008, the Examiner has argued that “Ronen further disclose that it is old and well known in the art of online shopping for the user to provide an ISP with billing information such as credit card number [user data].” Further, the Examiner has argued that “Ronen disclose the ordering of various goods and services being delivered by conventional transport means is old and well known in the art of online shopping.” Additionally, the Examiner has argued that “[i]t is obvious from Ronen that in order to deliver goods via conventional transport means, the ISP must be provided with the user’s shipping information...-see Background of the Invention, col. 1.”

Appellant respectfully disagrees and asserts that the excerpt from Ronen relied upon by the Examiner merely discloses that “the Internet can provide users a mechanism for ordering various goods and services, including tickets and merchandise, that will later be delivered by conventional transport means” (Col. 1, lines 14-20 – emphasis added) and that “[b]illing for...

tangible goods or services ordered over the Internet and provided conventionally... requires the user to establish a financial relationship with each of the many different Internet Service Providers (ISPs)” (Col. 1, lines 22-28 – emphasis added).

However, disclosing that the Internet can provide users a mechanism for ordering various goods and services that will later be delivered by conventional transport means, in addition to disclosing that billing for tangible goods and services ordered over the Internet and provided conventionally requires the user to establish a financial relationship, as in Ronen, simply fails to suggest a technique where “user data [that includes shipping information] is identified based on received information,” where such received information “includes an Internet Protocol (IP) address of a user and an amount of payment due” (emphasis added), in the context claimed by appellant. Clearly, the disclosure that billing for tangible goods and services ordered over the Internet and provided conventionally requires the user to establish a financial relationship, as in Ronen, simply fails to even suggest that “user data [that includes shipping information] is identified based on received information” (emphasis added), in the context claimed by appellant.

Furthermore, in the Examiner’s Answer mailed 05/01/2008, the Examiner has argued that “Egendorf teaches ‘In a typical transaction in accordance with the present invention, from the customer’s point of view all use of the Internet appears to be conventional...If the vendor wishes, the vendor [site] may verify with the provider that the address supplied by the customer for shipment of the goods has been authorized by the customer...’ –see col. 3 line 40 to col. 4 line 6.”

Appellant respectfully asserts that the excerpt from Egendorf relied upon by the Examiner teaches that “[i]f the vendor wishes, the vendor may verify with the provider that the address supplied by the customer for shipment of the goods has been authorized by the customer in the same manner in which such verification would be made for the same transaction made over the telephone with a credit card” (Col. 4, lines 1-6 – emphasis added). However, the vendor verifying with the provider that the address supplied by the customer for shipment of the goods has been authorized by the customer, as in Egendorf, simply fails to suggest a technique where “user data [that includes shipping information] is identified based on received information,”

where such received information “includes an Internet Protocol (IP) address of a user and an amount of payment due” (emphasis added), in the context specifically claimed by appellant. Clearly, verifying that the address supplied by the customer for shipment of the goods has been authorized, as in Egendorf, simply fails to even suggest that “user data [that includes shipping information] is identified based on received information” (emphasis added), in the context claimed by appellant.

Based on the Examiner’s above noted argument, it appears that the Examiner has relied on an inherency argument regarding the above emphasized claim limitations. In view of the arguments made hereinabove, any such inherency argument has been adequately rebutted, and a notice of allowance or a specific prior art showing of such claim features, in combination with the remaining claim elements is respectfully requested (See MPEP 2112).

Further, in response, appellant asserts that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

In the Examiner’s Answer mailed 05/01/2008, the Examiner has argued that “the [a]ppellant is reminded that the claims are rejected under 35 U.S.C. § 103, and the [a]ppellant is directed to p. 7 of the Office Action wherein the Examiner clearly refers to the obviousness of the claim limitations.”

Appellant respectfully asserts that on Page 7 of the Office Action mailed 06/26/2007, and on Page 9 of the Examiner’s Answer mailed 05/01/2008, the Examiner has stated that “[i]t is obvious that in order for goods ordered online to be shipped to a consumer, the consumer must provide shipping information.” However, alleging that “it is obvious that... the consumer must

provide shipping information,” as alleged by the Examiner, simply fails to even suggest that “user data [that includes shipping information] is identified based on received information” (emphasis added), in the context claimed by appellant. Furthermore, appellant points out the remarks above which clearly show the manner in which appellant’s claimed technique is further distinguished from Ronen and Egendorf. Appellant thus formally requests a specific showing of the subject matter in ALL of the claims in any future action. Note excerpt from MPEP below.

“If the [appellant] traverses such an [Official Notice] assertion the examiner should cite a reference in support of his or her position.” See MPEP 2144.03.

Additionally, with respect to independent Claims 1, 13, and 25, the Examiner has relied on Col. 8, lines 42-63 and Cols. 7-8 from Foster to make a prior art showing of appellant’s claimed technique where “the site is provided with a confirmation number and the shipping information of the user and the user is provided with the confirmation number” (see this or similar, but not necessarily identical language in the aforementioned independent claims).

Appellant respectfully asserts that the excerpts from Foster relied upon by the Examiner merely teach that “[t]he message to the cardholder, shown at path 216 may be an order confirmation number or other indication that the order is to be placed,” and that “[t]he message to the merchant includes a unique order number and a pre-registered shipping address or an authorized alternate shipping address, as shown at path 218” (Col. 8, lines 45-50 - emphasis added). However, disclosing an order confirmation number sent to the cardholder and a unique order number sent to the merchant, as in Foster, fails specifically meet appellant’s claimed technique where “the site is provided with a confirmation number... and the user is provided with the confirmation number” (emphasis added), as claimed by appellant.

In the Examiner’s Answer mailed 05/01/2008, the Examiner has argued that “Ronen disclose (‘At decision step 214, if the presence of a billing mechanism is confirmed, at step 223, the ISP receives confirmation from the transaction server and provides the requested service to the user...the ISP receives confirmation that such an account has been billed...’) –see col. 7 lines 52-67.” Further, the Examiner has argued that “Foster teaches that once the cardholder and merchant agree on a transaction, a confirmation message including a confirmation number is sent

to the cardholder and a unique order number and cardholder shipping address is sent to the merchant...-see Fig. 3 and col. 8 lines 42-53.”

Appellant respectfully disagrees and asserts that the excerpt from Ronen relied upon by the Examiner merely teaches that “at step 223, the ISP receives confirmation from the transaction server [of the presence of a billing mechanism] and provides the requested service to the user, the latter including delivery of the requested information, the downloading of requested software, or a confirmation of an order” and that “[a]t step 225, the transaction server bills that account for the charges for the provided service, and at step 226, the ISP receives confirmation that such account has been billed” (Col. 7, lines 52-67 – emphasis added).

Furthermore, appellant respectfully asserts that the figure and excerpt from Foster relied upon by the Examiner teach that “[a]t block 320, if both tests at blocks 312 and 314 pass, the card company system replies to the predetermined OVRT addresses with an appropriate message to both the cardholder and the merchant” such that “[t]he message to the cardholder, shown at path 216 may be an order confirmation number or other indication that the order is to be placed” and “[t]he message to the merchant includes a unique order number and a pre-registered shipping address or an authorized alternate shipping address, as shown at path 218” (Col. 8, lines 42-50 – emphasis added).

However, teaching that an ISP receives confirmation from the transaction server of the presence of a billing mechanism and that the ISP provides the requested service to the user, where the requested service may include a confirmation of an order, and further teaching that the ISP receives confirmation that an account has been billed, as in Ronen, in addition to teaching that a card company system replies with an appropriate message to both a cardholder and a merchant, where the message to the cardholder includes an order confirmation number, and the message to the merchant includes a unique order number, as in Foster, fails to teach that “the site is provided with a confirmation number... and the user is provided with the confirmation number” (emphasis added), as claimed by appellant. Clearly, disclosing an ISP receiving confirmation of the presence of a billing mechanism as well as confirmation that the account has been billed, in addition to the ISP providing a confirmation of an order to a user, as in Ronen, and further disclosing replying with a message including an order confirmation number to a cardholder, and

replying with a message including a unique order number to a merchant, as in Foster, simply fails to teach that “the site is provided with a confirmation number... and the user is provided with the confirmation number” (emphasis added), as claimed by appellant.

Additionally, in the Examiner’s Answer mailed 05/01/2008, the Examiner has “cited prior art made of record and not relied upon considered pertinent to Appellant’s disclosure on page 12 of the final office action, in particular, US PG. Publication No. 2002/0069165 (O’Neil) discloses a confirmation number displayed to the user and to the merchant-see pars. [0026-0027].”

Appellant respectfully disagrees and asserts that the Examiner has relied on O’Neil, which constitutes a reference separate from those in the relevant rejection under 35 U.S.C. 103(a). Further, it is noted that the Examiner has failed to cite specific motivation in the relevant reference(s) to support the case for combining the O’Neil reference. The Examiner is reminded that the Federal Circuit requires that there must be some logical reason apparent from the evidence of record that would justify the combination or modification of references. In re Regel, 188 USPQ 132 (CCPA 1975). Thus, the reliance on the O’Neil reference, on its face, is clearly improper.

In addition, in the Examiner’s Answer mailed 05/01/2008, the Examiner has argued that “Claims 1,13, and 25 recite combinations which only unite old elements with no change in their respective functions and which yield predictable results.” Additionally, the Examiner has argued that “the claimed subject matter likely would have been obvious under KSR (KSR, 127 S. Ct. at 1741, 82 USPQ2d at 1396).”

Appellant respectfully disagrees and asserts that appellant has clearly shown how the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as argued hereinabove. Therefore, appellant’s claim limitations, as argued hereinabove, would not be obvious under *KSR*, as argued by the Examiner.

Furthermore, in the Examiner’s Answer mailed 05/01/2008, the Examiner has argued that “neither the Appellants’ Specification nor Appellants’ arguments present any evidence that modifying Ronen with the selected elements of Egendorf and Foster was uniquely challenging or

difficult for one of ordinary skill in the art.” Further, the Examiner has argued that “it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ronen to include the specific teaching of the user data including shipping information as taught by Egendorf and specific teaching of a confirmation number and user shipping information provided to the site and a confirmation number provided to the user of Foster in order to provide the merchant (site) with payment confirmation as well as an address to ship the merchandise.” Additionally, the Examiner has argued that “[b]ecause this is a case where the improvements are no more than the predictable use of prior art elements according to their established functions, no further analysis is required by the Examiner... KSR, 127 S. Ct. at 1740, 82 USPQ2d at 1396.”

Appellant respectfully disagrees and asserts that the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as shown hereinabove.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on appellant’s disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

Group #2: Claim 26

With respect to independent Claim 26, the Examiner has relied on Col. 8, lines 42-63 and Cols. 7-8 from Foster to make a prior art showing of appellant’s claimed technique where “the site is

provided with a confirmation number and the shipping information and the user is provided with the confirmation number.”

Appellant respectfully asserts that the excerpts from Foster relied upon by the Examiner merely teach that “[t]he message to the cardholder, shown at path 216 may be an order confirmation number or other indication that the order is to be placed,” and that “[t]he message to the merchant includes a unique order number and a pre-registered shipping address or an authorized alternate shipping address, as shown at path 218” (Col. 8, lines 45-50 - emphasis added). However, disclosing an order confirmation number sent to the cardholder and a unique order number sent to the merchant, as in Foster, fails specifically meet appellant’s claimed technique where “the site is provided with a confirmation number ... and the user is provided with the confirmation number” (emphasis added), as claimed by appellant.

In the Examiner’s Answer mailed 05/01/2008, the Examiner has argued that “Ronen disclose (‘At decision step 214, if the presence of a billing mechanism is confirmed, at step 223, the ISP receives confirmation from the transaction server and provides the requested service to the user...the ISP receives confirmation that such an account has been billed...’) –see col. 7 lines 52-67.” Further, the Examiner has argued that “Foster teaches that once the cardholder and merchant agree on a transaction, a confirmation message including a confirmation number is sent to the cardholder and a unique order number and cardholder shipping address is sent to the merchant...-see Fig. 3 and col. 8 lines 42-53.”

Appellant respectfully disagrees and asserts that the excerpt from Ronen relied upon by the Examiner merely teaches that “at step 223, the ISP receives confirmation from the transaction server [of the presence of a billing mechanism] and provides the requested service to the user, the latter including delivery of the requested information, the downloading of requested software, or a confirmation of an order” and that “[a]t step 225, the transaction server bills that account for the charges for the provided service, and at step 226, the ISP receives confirmation that such account has been billed” (Col. 7, lines 52-67 – emphasis added).

However, teaching that an ISP receives confirmation from the transaction server of the presence of a billing mechanism and that the ISP provides the requested service to the user, where the

requested service may include a confirmation of an order, and further teaching that the ISP receives confirmation that an account has been billed, as in Ronen, in addition to teaching that the card company system replies with an appropriate message to both the cardholder and the merchant, where the message to the cardholder includes an order confirmation number and the message to the merchant includes a unique order number, as in Foster, fails to teach that “the site is provided with a confirmation number ... and the user is provided with the confirmation number” (emphasis added), as claimed by appellant. Clearly, disclosing an ISP receiving confirmation of the presence of a billing mechanism as well as confirmation that the account has been billed, in addition to the ISP providing a confirmation of an order to a user, as in Ronen, and further disclosing replying with a message including an order confirmation number to the cardholder, and replying with a message including a unique order number to the merchant, as in Foster, simply fails to teach that “the site is provided with a confirmation number ... and the user is provided with the confirmation number” (emphasis added), as claimed by appellant.

Additionally, in the Examiner’s Answer mailed 05/01/2008, the Examiner has “cited prior art made of record and not relied upon considered pertinent to Appellant’s disclosure on page 12 of the final office action, in particular, US PG. Publication No. 2002/0069165 (O’Neil) discloses a confirmation number displayed to the user and to the merchant-see pars. [0026-0027].”

Appellant respectfully disagrees and asserts that the Examiner has relied on O’Neil, which constitutes a reference separate from those in the relevant rejection under 35 U.S.C. 103(a). Further, it is noted that the Examiner has failed to cite specific motivation in the relevant reference(s) to support the case for combining the O’Neil reference. The Examiner is reminded that the Federal Circuit requires that there must be some logical reason apparent from the evidence of record that would justify the combination or modification of references. In re Regel, 188 USPQ 132 (CCPA 1975). Thus, the reliance on the O’Neil reference, on its face, is clearly improper.

Additionally, with respect to independent Claim 26, the Examiner has relied on Cols. 1 and 2 from Ronen to make a prior art showing of appellant’s claimed “providing a link to a site on a network where a business transaction is occurring.”

Appellant respectfully asserts that the excerpt from Ronen relied on by the Examiner only generally discloses “transaction[s] conducted over the Internet by users connected through an Internet Access Provider (IAP) to one or more ISPs” (Col. 2, lines 5-8). However, appellant respectfully notes that nowhere in the excerpt relied on by the Examiner is there any specific disclosure of “providing a link to a site on a network where a business transaction is occurring” (emphasis added), as appellant claims.

In the Examiner’s Answer mailed 05/01/2008, the Examiner has argued that in “col. 1... Ronen discloses accessing the Internet which provides users a mechanism for ordering goods and services.” Further, the Examiner has argued that “Ronen... discloses allowing the user interacts with a transaction server to provide his or her selected choices for how charges for a transaction on the Internet are to be billed, in particular, see Fig. 1 (refs. 101, 103,104,115,116,109,111) and related text; cols. 4-5.”

Appellant respectfully disagrees and asserts that the figure and excerpts from Ronen relied upon by the Examiner merely teach that “the Internet can provide users a mechanism for ordering various goods and services... and for ordering and receiving non-tangible goods” (Col. 1, lines 14-20 – emphasis added). Further, the figure and excerpts teach that “[i]n establishing the billing mechanism the user interacts with the transaction server 109” and that “the user provides his or her selected choices for how charges for transactions on the Internet are to be billed” (Col. 4, lines 20-25 – emphasis added). Additionally, the figure and excerpts teach “an identifying address[,]. . . the identity of the user, [and]. . . the user’s ANI” (Col. 5, lines 18-25), where “this information can be transmitted to transaction server 109 over a secured Internet link over transmission facilities 115 and 116, which are distinguished in FIG. 1 from non-secure Internet links by their thicker lead lines” (Col. 5, lines 32-36 – emphasis added).

However, disclosing that the Internet can provide users a mechanism for ordering various goods and services, that a user provides selected choices for how charges for transactions on the Internet are to be billed, and that information is transmitted to the transaction server over a secured Internet link, as in Ronen, fails to suggest “providing a link to a site on a network where a business transaction is occurring” (emphasis added), as appellant claims. Clearly, a user providing selected choices for how charges for transactions on the Internet are to be billed, as in

Ronen, simply fails to even suggest “a link to a site on a network where a business transaction is occurring” (emphasis added), as appellant claims.

Also with respect to independent Claim 26, the Examiner has relied on the rejection of Claim 8, and in particular Col. 7, lines 37-40 and item 120-3 in Figure 1 of Ronen, to make a prior art showing of appellant’s claimed “conditionally administering payment for the payment due by billing against the account in accordance with any identified rules.”

Appellant respectfully asserts that item 120-3 in Figure 1 of Ronen merely shows a bank debit card. Further, Col. 7, lines 37-40 from Ronen simply discloses that the “billing mechanism will include the user’s desired method or methods of billing, and any parameters that define when a particular billing method is to be applied.” Clearly, parameters that define when a particular billing method is to be applied, as in Ronen, fails to meet appellant’s claimed “conditionally administering payment...in accordance with any identified rules” (emphasis added), as claimed. In fact, appellant notes Table 1 in Ronen (shown in Col. 4, lines 50-60), which clearly shows parameters for each billing choice, which does not teach that “payment [is conditionally administered]... in accordance with any identified rules” (emphasis added), as claimed.

In the Examiner’s Answer mailed 05/01/2008, the Examiner has argued that “Ronen disclose that a user has arranged for centralized billing functionality a record that includes the parameters of billing and the billing choice.” Further, the Examiner has argued that “Table 1 of Ronen discloses the user ID, and if a parameter is met [condition], administering payment as designated by the parameter [billing the account in accordance with identified rules].” Additionally, the Examiner has argued that “[i]n the example provided in table 1, if John Smith purchases tangible goods amounting to less than or equal to \$40.00, the Chase Debit Account will be used as the payment method” and that “[i]f John Smith purchases items from Sears, the parameter [condition] is that all purchases from Sears are to be billed using the Sears account.” Furthermore, the Examiner has concluded that “[t]herefore, Ronen teaches conditionally administering payment in accordance with identified rules.”

Appellant respectfully disagrees and asserts that Ronen teaches that “[b]illing server 111 thus has stored on database 112 for each user who has arranged for such centralized billing functionality a

record that includes the parameters of billing and the billing choice” where Table 1 includes the columns of “User ID,” “Parameters,” and “Billing Choice” (Col. 43-60 – emphasis added). Further, Ronen teaches that “the ISP sends the user a URL to an HTML page for selecting a billing mechanism,” where “this billing mechanism will include the user’s desired method or methods of billing, and any parameters that define when a particular billing method is to be applied,” and that “[t]he user, at step 219, selects the desired billing mechanism, which is sent to the transaction server” (Col. 7, lines 34-42 – emphasis added).

However, teaching a record that includes the parameters of billing and the billing choice, where the record includes User ID, Parameters, and Billing Choice, in addition to teaching that a billing mechanism includes the user’s desired method or methods of billing and any parameters that define when a particular billing method is to be applied, where the user selects the desired billing mechanism, as in Ronen, fails to teach that “payment [is conditionally administered]... in accordance with any identified rules” (emphasis added), as claimed. Clearly, a user selecting the desired billing mechanism, where the billing mechanism includes any parameters that define when a particular billing method is to be applied, as in Ronen, simply fails to teach that “payment [is conditionally administered]... in accordance with any identified rules” (emphasis added), as claimed.

Still with respect to independent Claim 26, the Examiner has relied on Col. 4, lines 1-6 in Egendorf to make a prior art showing of appellant’s claimed “identifying shipping information based on the received information.”

Appellant respectfully emphasizes that the excerpt from Egendorf relied on by the Examiner simply discloses that “the vendor may verify with the provider that the address supplied by the customer for shipment of the goods has been authorized by the customer” (Egendorf, Col. 4, lines 1-3 - emphasis added). Clearly, simply verifying an address supplied by a customer, as in Egendorf, fails to specifically teach, and even *teaches away* from, appellant’s claimed “identifying shipping information based on the received information,” especially where such received “information includes an Internet Protocol (IP) address of [the] user and an amount of payment due” (emphasis added), in the context claimed.

In addition, although Egendorf discloses that “the vendor may verify with the provider that the address... has been authorized by the customer,” Egendorf only discloses that such verification may be performed “in the same manner in which such verification would be made for the same transaction made over the telephone with a credit card.” Thus, Egendorf simply does not meet appellant’s specific claim language.

In the Examiner’s Answer mailed 05/01/2008, the Examiner has argued that “columns 2, 5, and 6...[in] Ronen disclose a billing platform which uses the IP address identity of the user [received information].” Further, the Examiner has argued that in “col. 1 lines 13-20, Ronen disclose that the billing server cross-references the IP address associated with the cost of the transaction received from the ISP with the IP address/user-identity relationship received from the IAP to properly charge an established account of the user [user data is identified].”

Appellant respectfully disagrees and asserts that the excerpts from Ronen relied upon by the Examiner teach that “the Internet Protocol (IP) address that is assigned to the user by the IAP upon connection, is transmitted to a billing platform together with the associated identity of the user, which is known to the IAP through normal log-on procedures” (Col. 2, lines 8-13 – emphasis added). Further, the excerpts teach that “[t]he billing server then cross-references the IP address associated with the cost of the transaction received from the ISP with the IP-address/user-identity relationship received from the IAP to properly charge an established account of the user for the transaction” (Col. 2, lines 16-20 – emphasis added).

However, teaching that an ISP transmits an IP address identity of a user making a transaction and the cost of the transaction to a billing platform, where a billing server cross-references the IP address with an IP-address/user-identity relationship received from the IAP to properly charge an established account of the user for the transaction, as in Ronen, simply fails to suggest “identifying shipping information based on the received information,” especially where such received “information includes an Internet Protocol (IP) address of [the] user and an amount of payment due” (emphasis added), in the context claimed by appellant. Clearly, cross-referencing the IP address associated with the cost of the transaction with the IP-address/user-identity relationship in order to properly charge an established account of the user for the transaction, as

in Ronen, simply fails to even suggest “identifying shipping information based on the received information” (emphasis added), in the context claimed by appellant.

Additionally, in the Examiner’s Answer mailed 05/01/2008, the Examiner has argued that “Ronen further disclose that it is old and well known in the art of online shopping for the user to provide an ISP with billing information such as credit card number [user data].” Further, the Examiner has argued that “Ronen disclose the ordering of various goods and services being delivered by conventional transport means is old and well known in the art of online shopping.” Additionally, the Examiner has argued that “[i]t is obvious from Ronen that in order to deliver goods via conventional transport means, the ISP must be provided with the user’s shipping information...-see Background of the Invention, col. 1.”

Appellant respectfully disagrees and asserts that the excerpt from Ronen relied upon by the Examiner merely discloses that “the Internet can provide users a mechanism for ordering various goods and services, including tickets and merchandise, that will later be delivered by conventional transport means” (Col. 1, lines 14-20 – emphasis added) and that “[b]illing for... tangible goods or services ordered over the Internet and provided conventionally... requires the user to establish a financial relationship with each of the many different Internet Service Providers (ISPs)” (Col. 1, lines 22-28 – emphasis added).

However, disclosing that the Internet can provide users a mechanism for ordering various goods and services that will later be delivered by conventional transport means, in addition to disclosing that billing for tangible goods and services ordered over the Internet and provided conventionally requires the user to establish a financial relationship, as in Ronen, simply fails to suggest “identifying shipping information based on the received information,” especially where such received “information includes an Internet Protocol (IP) address of [the] user and an amount of payment due” (emphasis added), in the context claimed by appellant. Clearly, the disclosure that billing for tangible goods and services ordered over the Internet and provided conventionally requires the user to establish a financial relationship, as in Ronen, simply fails to even suggest that “identifying shipping information based on the received information” (emphasis added), in the context claimed by appellant.

Furthermore, in the Examiner's Answer mailed 05/01/2008, the Examiner has argued that "Egendorf teaches 'In a typical transaction in accordance with the present invention, from the customer's point of view all use of the Internet appears to be conventional...If the vendor wishes, the vendor [site] may verify with the provider that the address supplied by the customer for shipment of the goods has been authorized by the customer...' –see col. 3 line 40 to col. 4 line 6."

Appellant respectfully asserts that the excerpt from Egendorf relied upon by the Examiner teaches that "[i]f the vendor wishes, the vendor may verify with the provider that the address supplied by the customer for shipment of the goods has been authorized by the customer in the same manner in which such verification would be made for the same transaction made over the telephone with a credit card" (Col. , lines 1-6 – emphasis added). However, the vendor verifying with the provider that the address supplied by the customer for shipment of the goods has been authorized by the customer, as in Egendorf, simply fails to suggest "identifying shipping information based on the received information," especially where such received "information includes an Internet Protocol (IP) address of [the] user and an amount of payment due" (emphasis added), in the context specifically claimed by appellant. Clearly, verifying that the address supplied by the customer for shipment of the goods has been authorized, as in Egendorf, simply fails to even suggest that "identifying shipping information based on the received information" (emphasis added), in the context claimed by appellant.

Again, appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

Group #3: Claim 30

With respect to dependent Claim 30, the Examiner has relied on Col. 4 in Ronen, and particularly Ronen's disclosed parameters of billing and billing choice in Table 1 of Col. 4, to make a prior art showing of appellant's claimed technique "wherein the rule identifies at least one category in which goods or services are permitted to be purchased."

Appellant notes that the reference excerpt relied on by the Examiner, which describes Table 1 in Ronen, merely discloses that “the user may specify that certain transactions, depending upon the type of transaction, be billed in a specific manner” (Col. 4, lines 26-28 - emphasis added). Such excerpt further teaches that “the user may want all transactions involving purchases from a specified retailer to be billed to that retailer's own credit card, and other purchases to be billed to a bank credit card,” and “[c]harges for transactions of a certain type for less than a predetermined amount may be designated for billing to an identified telephone account associated with the user,” while “charges for transactions for greater than some other predetermined amount may be designated for billing to an identified debit account” (Col. 4, lines 28-38).

However, merely disclosing that a user may specify that certain transactions be billed in a certain manner, as in Ronen, fails to teach a technique “wherein the rule identifies at least one category in which goods or services are permitted to be purchased” (emphasis added), as claimed by appellant.

In the Examiner’s Answer mailed 05/01/2008, the Examiner has argued that “Ronen disclose ‘In addition, the user may specify that certain transactions, depending upon the type of transaction, be billed in a specific manner...’ –see col. 4 lines 27-65; col. 6 lines 20-23.”

Appellant respectfully disagrees and asserts that the excerpts from Ronen relied upon by the Examiner disclose that “[i]n establishing the billing mechanism the user interacts with the transaction server 109” and that “the user provides his or her selected choices for how charges for transactions on the Internet are to be billed” (Col. 4, lines 20-24 – emphasis added). Further, the excerpts disclose that “[i]n addition, the user may specify that certain transactions, depending upon the type of transaction, be billed in a specific manner” (Col. 4, lines 26-28 – emphasis added). Additionally, the excerpts teach that “[b]illing server 111 associates each transaction within the session for billing in accordance with the billing mechanism established by the user, such as shown in Table 1 above” (Col. 6, lines 20-23 – emphasis added).

However, disclosing that the user provides selected choices for how charges for transactions are to be billed, that the user may specify that certain transactions be billed in a specific manner, and that the billing server associates each transaction within the session for billing in accordance with

the billing mechanism established by the user, as in Ronen, simply fails to suggest a technique “wherein the rule identifies at least one category in which goods or services are permitted to be purchased” (emphasis added), as claimed by appellant. Clearly, providing choices for how chargers for transactions are to be billed, specifying that certain transactions be billed in a specific manner, and associating each transaction for billing in accordance with the billing mechanism established by the user, as in as in Ronen, simply fails to suggest that “the rule identifies at least one category in which goods or services are permitted to be purchased” (emphasis added), as claimed by appellant.

Again, appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

Issue # 3:

The Examiner has rejected Claims 12 and 24 under 35 U.S.C. 103(a) as being unpatentable over Ronen (U.S. Patent No. 5,905,736), in view of Egendorf (U.S. Patent No. 5,794,221), in further view of Foster (U.S. Patent No. 6,332,134), and in further view of Wilf et al. (U.S. Patent No. 5,899,980).

Group #1: Claim 12

With respect to dependent Claim 12, the Examiner has relied on Col. 7, lines 26-33 in Wilf to make a prior art showing of appellant’s claimed technique “wherein the receiving, the identifying, and the administering are carried out by a financial institution offering credit with credit cards in conjunction with the network service provider.”

Appellant notes that the reference excerpt relied on by the Examiner merely discloses that “[t]he [secure transaction service provider], the customers, the vendors and the ISPs receive financial services from one or more financial service providers such as a credit card company or a bank or any other suitable financial service company” and that “[t]he [secure transaction service provider], the customers, the vendors and the ISPs have bank accounts or credit card accounts

with the financial service providers and can provide a bank account number or a credit card number for performing financial transactions” (Col. 7, lines 26-33 – emphasis added).

However, merely disclosing that a secure transaction service provider may receive financial services from a credit card company, in addition to disclosing that the secure transaction service provider can provide a bank account number or a credit card number for performing financial transactions, does not teach a technique “wherein the receiving... [and] the identifying... are carried out by a financial institution offering credit with credit cards in conjunction with the network service provider,” especially where the receiving includes “receiving information... wherein the information includes an Internet Protocol (IP) address of a user and an amount of payment due” and the identifying includes “identifying an account using at least a portion of the IP address” (emphasis added), in the context claimed by appellant (see independent Claim 1 for context).

In the Examiner’s Answer mailed 05/01/2008, the Examiner has stated that “the claim recites that the financial institution in conjunction with the network service provider carry out the receiving, the identifying, and the administering” and that “[t]he claim language does not specify the roles performed by the financial institution and the network service provider, therefore, the claim is interpreted based on the broadest, reasonable interpretation.”

Appellant respectfully disagrees with the Examiner’s interpretation and asserts that appellant clearly claims a technique “wherein the receiving, the identifying, and the administering are carried out by a financial institution offering credit with credit cards in conjunction with the network service provider,” as claimed.

Further, in the Examiner’s Answer mailed 05/01/2008, the Examiner has argued that “Wilf disclose a retail method over a wide area network including the steps of connecting one of the customer computer stations to one of the points of sale computer station, purchasing goods from the point of sale computer station by the customer operating the customer computer station, validating the purchasing by one of the transaction servers and one of the network service provider servers, charging the customer for the purchasing, the transaction including the steps of billing an account of the customer by the network service provider server a transaction sum and

billing by the transaction server an account of the network service provider server the transaction sum, supplying the goods to the customer, and remitting a portion of the transaction sum to a vendor operating the point of sale computer station.” Additionally, the Examiner has argued that “Wilf disclose the information for associating a customer and the information for associating the vendor are stored on the transaction server or accessible to the transaction server” and that “Wilf further disclose that the software module installed on the STSs (secure transaction servers) can identify the ISP of a customer having an IP address by accessing a database or table.” In addition, the Examiner has argued that “[t]he software module also manages the financial information needed for implementing the billing such as the credit card account numbers of the ISPs and vendors” and that “[t]he STSP (secure transaction service providers[]), the customers, the vendors, and the ISPs receive financial services from one or more financial service providers such as a credit card company or bank or any other suitable financial service company.” Furthermore, the Examiner has argued that “[t]he financial service provider transfers the proper amounts from the ISPs to the relevant vendors” and that “[t]he financial service provider may also deduct a commission for itself and/or for the STSP and/or for the ISP.”

Appellant respectfully disagrees and asserts that Wilf teaches that “FIG. 5 is a schematic flow chart illustrating the steps of a method for Internet billing performed by an ISP server of the system of FIG. 1” (Col. 11, lines 46-49 – emphasis added). Further, Wilf teaches that “[t]he ISP server receives the transaction details from the transaction verification form as filled by the customer (step 124) and connects to an available STS (step 126)” and that “[t]he ISP server identifies the customer identity according to the communication session details (step 127)” where “[t]he customer identity may be an ID number or a user name which is used by the ISP for identifying the customer” (Col. 11, lines 49-56 – emphasis added). In addition, Wilf teaches that “[i]f the customer is certified, the ISP server informs the STS that the payment is authorized and transfers the transaction details to the STS for verification (step 134)” and that “[t]he ISP server then records the transaction details for billing the customer (step 136) and transfers control to step 124” (Col. 11, line 67-Col. 12, line 5 – emphasis added). Additionally, Wilf teaches that “the STSP provides the financial service such as the bank or the credit card company with periodic reports including the details of all the transactions performed over a period of time” and that “[t]he financial service provider transfers the proper amounts from the ISPs to the relevant vendors” (Col. 9, lines 21-31 – emphasis added).

However, the ISP server receiving the transaction details, identifying the customer identity, such as an ID number, according to the communication session details, and transferring the transaction details to the STS, in addition to the STSP providing the financial service with periodic reports including the details of all the transactions performed, and the financial service provider transferring the proper amounts from the ISPs to the relevant vendors, as in Wilf, does not teach a technique “wherein the receiving, the identifying, and the administering are carried out by a financial institution offering credit with credit cards in conjunction with the network service provider,” especially where the receiving includes “receiving information... wherein the information includes an Internet Protocol (IP) address of a user and an amount of payment due” and the identifying includes “identifying an account using at least a portion of the IP address” (emphasis added), in the context claimed by appellant (see independent Claim 1 for context). Clearly, the ISP server receiving the transaction details, identifying the customer identity according to the communication session details, and transferring the transaction details, as in Wilf, simply fails to teach that “the receiving... [and] the identifying... are carried out by a financial institution” (emphasis added), as claimed by appellant.

Again, appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

Group #2: Claim 24

With respect to dependent Claim 24, the Examiner has relied on Col. 7, lines 26-33 in Wilf to make a prior art showing of appellant’s claimed technique “wherein the computer code is executed by a financial institution offering credit with credit cards in conjunction with the network service provider.”

Appellant notes that the reference excerpt relied on by the Examiner merely discloses that “[t]he [secure transaction service provider], the customers, the vendors and the ISPs receive financial services from one or more financial service providers such as a credit card company or a bank or any other suitable financial service company” and that “[t]he [secure transaction service

provider], the customers, the vendors and the ISPs have bank accounts or credit card accounts with the financial service providers and can provide a bank account number or a credit card number for performing financial transactions” (Col. 7, lines 26-33 – emphasis added).

However, merely disclosing that a secure transaction service provider may receive financial services from a credit card company, in addition to disclosing that the secure transaction service provider can provide a bank account number or a credit card number for performing financial transactions, does not teach a technique “wherein the computer code is executed by a financial institution offering credit with credit cards in conjunction with the network service provider,” where the computer code includes “computer code for receiving information utilizing a network... computer code for identifying an account using at least a portion of the IP address... [and] computer code for identifying user data based on the received information, and sending the user data to a site” (see Claim 13 - emphasis added), in the context claimed by appellant.

In the Examiner’s Answer mailed 05/01/2008, the Examiner has stated that “the claim recites that the financial institution in conjunction with the network service provider carry out the receiving, the identifying, and the administering” and that “[t]he claim language does not specify the roles performed by the financial institution and the network service provider, therefore, the claim is interpreted based on the broadest, reasonable interpretation.”

Appellant respectfully disagrees with the Examiner’s interpretation and asserts that appellant clearly claims a technique “wherein the computer code is executed by a financial institution offering credit with credit cards in conjunction with the network service provider,” as claimed.

Further, in the Examiner’s Answer mailed 05/01/2008, the Examiner has argued that “Wilf disclose a retail method over a wide area network including the steps of connecting one of the customer computer stations to one of the points of sale computer station, purchasing goods from the point of sale computer station by the customer operating the customer computer station, validating the purchasing by one of the transaction servers and one of the network service provider servers, charging the customer for the purchasing, the transaction including the steps of billing an account of the customer by the network service provider server a transaction sum and billing by the transaction server an account of the network service provider server the transaction

sum, supplying the goods to the customer, and remitting a portion of the transaction sum to a vendor operating the point of sale computer station.” Additionally, the Examiner has argued that “Wilf disclose the information for associating a customer and the information for associating the vendor are stored on the transaction server or accessible to the transaction server” and that “Wilf further disclose that the software module installed on the STSs (secure transaction servers) can identify the ISP of a customer having an IP address by accessing a database or table.” In addition, the Examiner has argued that “[t]he software module also manages the financial information needed for implementing the billing such as the credit card account numbers of the ISPs and vendors” and that “[t]he STSP (secure transaction service providers[]), the customers, the vendors, and the ISPs receive financial services from one or more financial service providers such as a credit card company or bank or any other suitable financial service company.” Furthermore, the Examiner has argued that “[t]he financial service provider transfers the proper amounts from the ISPs to the relevant vendors” and that “[t]he financial service provider may also deduct a commission for itself and/or for the STSP and/or for the ISP.”

Appellant respectfully disagrees and asserts that Wilf teaches that “FIG. 5 is a schematic flow chart illustrating the steps of a method for Internet billing performed by an ISP server of the system of FIG. 1” (Col. 11, lines 46-49 – emphasis added). Further, Wilf teaches that “[t]he ISP server receives the transaction details from the transaction verification form as filled by the customer (step 124) and connects to an available STS (step 126)” and that “[t]he ISP server identifies the customer identity according to the communication session details (step 127)” where “[t]he customer identity may be an ID number or a user name which is used by the ISP for identifying the customer” (Col. 11, lines 49-56 – emphasis added). In addition, Wilf teaches that “[i]f the customer is certified, the ISP server informs the STS that the payment is authorized and transfers the transaction details to the STS for verification (step 134)” and that “[t]he ISP server then records the transaction details for billing the customer (step 136) and transfers control to step 124” (Col. 11, line 67-Col. 12, line 5 – emphasis added). Additionally, Wilf teaches that “the STSP provides the financial service such as the bank or the credit card company with periodic reports including the details of all the transactions performed over a period of time” and that “[t]he financial service provider transfers the proper amounts from the ISPs to the relevant vendors” (Col. 9, lines 21-31 – emphasis added).

However, the ISP server receiving the transaction details, identifying the customer identity, such as an ID number, according to the communication session details, and transferring the transaction details to the STS, in addition to the STSP providing the financial service with periodic reports including the details of all the transactions performed, and the financial service provider transferring the proper amounts from the ISPs to the relevant vendors, as in Wilf, does not teach a technique “wherein the computer code is executed by a financial institution offering credit with credit cards in conjunction with the network service provider,” where the computer code includes “computer code for receiving information utilizing a network... computer code for identifying an account using at least a portion of the IP address... [and] computer code for identifying user data based on the received information, and sending the user data to a site” (emphasis added), in the context claimed by appellant (see independent Claim 13 for context). Clearly, the ISP server receiving the transaction details, identifying the customer identity according to the communication session details, and transferring the transaction details, as in Wilf, simply fails to teach that “the computer code is executed by a financial institution” (emphasis added), in the context as claimed by appellant.

Again, appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

Issue # 4:

The Examiner has rejected Claims 3 and 15 under 35 U.S.C. 103(a) as being unpatentable over Ronen (U.S. Patent No. 5,905,736), in view of Egendorf (U.S. Patent No. 5,794,221), in further view of Foster (U.S. Patent No. 6,332,134), and in further view of *Connecting with confidence (Web Techniques)* by John Stewart.

Group #1: Claims 3 and 15

With respect to dependent Claim 3 et al., the Examiner has relied on Page 3, paragraph 2 in Stewart to make a prior art showing of appellant’s claimed technique “wherein the information further includes port numbers.” More specifically, the Examiner has argued that “[i]t is well-

known in the art as evidenced by Stewart, that port numbers are a way to identify a specific process to which an internet message is to be forwarded when it arrives at a server.”

Appellant respectfully disagrees and notes that the excerpt relied on by the Examiner merely teaches that “[a]ccess control lists... [c]ontrol which machines (using IP addresses) can talk to one another on what services [(]using network port numbers)” and that “[t]he data being sent back and forth over each channel is not inspected-all that is scrutinized is whether it’s using a network port that is explicitly permitted” (Page 3, second full paragraph – emphasis added).

However, merely disclosing determining whether a permitted network port is being used, and that access control lists control what services machines can talk to each other on, does not teach a technique “wherein the information further includes port numbers” (emphasis added), particularly where “the site sends the information in response to the user carrying out a transaction,” in the context claimed by appellant (see independent Claims 1 and 13 for context).

Thus, in response to the Examiner’s apparent reliance on Official Notice in stating that “[i]t is well-known in the art as evidenced by Stewart, that port numbers are a way to identify a specific process to which an internet message is to be forwarded when it arrives at a server,” appellant points out the remarks above that clearly show the manner in which some of such claims further distinguish Stewart. Appellant thus formally requests a specific showing of the subject matter in ALL of the claims in any future action. Note excerpt from MPEP below.

“If the [appellant] traverses such an [Official Notice] assertion the examiner should cite a reference in support of his or her position.” See MPEP 2144.03.

In the Examiner’s Answer mailed 05/01/2008, the Examiner has argued that “[t]he [a]ppellant is reminded that the Examiner did take official noticed as evidenced by Stewart” and “[t]herefore, support was provided by the Examiner.” Further, the Examiner has argued that “Stewart teaches controlling network traffic includes controlling which machines (using IP addresses) can talk to one another on what services [using port numbers].” Additionally, the Examiner has argued that “[a]n internet port is a virtual entrance way between a user computer and the Internet” such that “[w]hen an Internet connections is made, many of these virtual connections are opened up, and

each has its own number and purpose.” In addition, the Examiner has stated that “[f]or example, FTP software usually connects to FTP servers using a designated port (usually number 21).” Furthermore, the Examiner has stated that “[t]he Stewart reference was used to support what is already well known in the art (i.e., port numbers are commonplace).”

Appellant respectfully disagrees and asserts that Stewart teaches that “[a]ccess control lists (ACLs) are a very basic method for permitting or denying traffic from one network to another” and that “[ACL] rules are simple: Control which machines (using IP addresses) can talk to one another on what services [(using network port numbers)” (Page 3, fourth paragraph – emphasis added). Clearly, teaching that ACLs control which machines can talk to one another on what services, using IP addresses and network port numbers, as in Stewart, does not teach a technique “wherein the information further includes port numbers” (emphasis added), particularly where “the site sends the information in response to the user carrying out a transaction,” in the context claimed by appellant (see independent Claims 1 and 13 for context). Clearly, merely controlling which services machines can talk to one another on using IP addresses and network port numbers, as in Stewart, does not teach a technique “wherein the information further includes port numbers” (emphasis added), as claimed by appellant.

Again, appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

In view of the remarks set forth hereinabove, all of the independent claims are deemed allowable, along with any claims depending therefrom.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 971-2573. For payment of any additional fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1351 (Order No. AMDCP006).

Respectfully submitted,

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